Paper No. 9
Hohein/md

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 10/6/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re J. Paul Martha

Serial No. 75/027,857

David V. Radack, Esq. for J. Paul Martha.

Alan C. Atchison, Trademark Examining Attorney, Law Office 102 (Myra K. Kurzbard, Managing Attorney).

Before Simms, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

J. Paul Martha has filed an application to register the phrase "INTERNATIONAL BASKETBALL LEAGUE" for "entertainment services, namely organizing and conducting basketball competitions and exhibitions."[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the

[1] Ser. No. 75/027,857, filed on December 5, 1995, which alleges a bona fide intention to use such phrase in commerce. The words "BASKETBALL LEAGUE" have been voluntarily disclaimed.

phrase "INTERNATIONAL BASKETBALL LEAGUE" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Relying upon a third-party registration mentioned for the first time in its brief,[2] applicant asserts that in view of its analogous disclaimer of the words "BASKETBALL LEAGUE," "the term '*INTERNATIONAL*' can function to distinguish Appellant's services from those of another and thus the entire mark is not [merely] descriptive." Specifically, while noting that the Examining Attorney has made of record "a dictionary definition of '*INTERNATIONAL*' as well as several third[-]party registrations" which include disclaimers of such term,[3] applicant contends that:

[2] We note, however, that not only is the reference to such registration untimely under Trademark Rule 2.142(d), but in any event a mere listing of a third-party registration is insufficient to make it of record inasmuch as the Board does not take judicial notice of registrations which reside in the Patent and Trademark Office. See, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). The proper procedure for making information concerning a third-party registration of record is, instead, to submit either a copy of the actual registration or the electronic equivalent thereof, i.e., a printout of the registration which has been taken from the Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3; and In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Nevertheless, since the Examining Attorney has not only elected not to object to consideration of the information concerning the third-party registration, but has treated it as being of record by discussing it in his brief, we have considered such evidence for whatever probative value it may have. See In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 (TTAB 1990) at n. 2.

[3] Applicant also points out that the Examining Attorney, in support of the refusal to register, has made of record copies of two other third-party registrations, namely, "Registration No. 1,375,316 for [the mark] '*UNITED STATES BASKETBALL LEAGUE*' which is registered on the *SUPPLEMENTAL REGISTER* and ... Registration No. 1,381,843 for [the mark] '*USBL UNITED STATES BASKETBALL LEAGUE and Design*', in which the

> Countering these registrations, however, Appellant makes of record U.S. Service Mark Registration No. 1,546,808 for the mark "*INTERNATIONAL FOOTBALL LEAGUE*" ("*the '808 Registration*"). Although this registration has been cancelled, it is evidence of United States Patent and Trademark Office precedent finding that a very similar mark to Appellant's was registered on the *PRINCIPAL REGISTER*.
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> Notwithstanding the third[-]party registrations cited by the Trademark Examining Attorney, Appellant believes that the proper result in this case is that the mark is not descriptive and that the precedent of the '808 Registration is more sound .... It is still Appellant's contention that the word "*INTERNATIONAL*" is not descriptive when applied to Appellant's services ant [sic] thus the Trademark Examining Attorney's descriptiveness refusal is improper and should be reversed.

The Examining Attorney, on the other hand, argues that because the phrase "INTERNATIONAL BASKETBALL LEAGUE" immediately identifies "features of the applicant's services, namely, an international league of basketball players and/or competitions," the term "INTERNATIONAL" is merely descriptive thereof and the words "BASKETBALL LEAGUE" constitute generic terms. Therefore, and in view of applicant's acknowledgment of the latter by virtue of his disclaimer of the words "BASKETBALL LEAGUE," the Examining

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terms '*UNITED STATES BASKETBALL LEAGUE*' have been disclaimed." While, in each instance, such marks are registered for "entertainment services, namely organizing and conducting basketball competitions and exhibitions," it would appear that the marks are so registered because the phrase "UNITED STATES BASKETBALL LEAGUE" was considered to be primarily geographically descriptive of those services, within the meaning of Section 2(e)(2) of the Trademark Act, 15. U.S.C. §1052(e)(2), rather than because it was found to be merely descriptive thereof. Such evidence, other than showing the descriptiveness of the words "BASKETBALL LEAGUE" (which applicant in any event has conceded by virtue of the voluntary disclaimer thereof), is thus of limited probative value as to the issue of mere descriptiveness in this appeal.

Attorney maintains that "the entire mark ... is merely descriptive." In support of his position, the Examining Attorney has made of record a definition from Webster's II New Riverside University Dictionary (1988) which lists "international" as an adjective meaning "**1.** Of, pertaining to, or involving two or more nations. **2.** Extending across two or more national borders."[4]

The Examining Attorney has also furnished with his final refusal copies of the following third-party registrations to show that, by including a disclaimer of the term "INTERNATIONAL," it is the current practice of the Patent and Trademark Office to regard such term as merely descriptive when used in connection with marks which contain that term and which are registered for sporting events or competitions:

> (1) Reg. No. 2,013,099, issued on November 5, 1996, for the mark "INTERNATIONAL SENIOR GAMES" and design for, inter alia, "organizing and conducting a series of competitions consisting of sports and cultural activities ... for individuals over the age of fifty years"; the words "INTERNATIONAL SENIOR GAMES" are disclaimed;
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> (2) Reg. No. 1,988,026, issued on July 23, 1996, for the mark "INTERNATIONAL MARTIAL ARTS GAMES KOIDE" for "organizing exhibitions for martial arts purposes and entertainment in the nature of martial arts games"; the words "INTERNATIONAL MARTIAL ARTS GAMES" are disclaimed;
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> (3) Reg. No. 1,977,806, issued on June 4, 1996, for the mark "INTERNATIONAL HOCKEY SCHOOLS" and design for "educational

[4] The same dictionary, the record shows, defines "basketball" in relevant part as a noun connoting "[a] game played between two teams of five players each, the object being to throw the ball through an elevated basket on the opponent's side of the rectangular court" and lists "league" in pertinent part as signifying "[a]n association of sports teams or clubs that compete chiefly among themselves."

> services, namely, conducting training camps in the field of hockey"; the words "INTERNATIONAL HOCKEY SCHOOLS" are disclaimed;
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> (4) Reg. No. 1,757,293, issued on March 9, 1993, for the mark "IJSBA INTERNATIONAL JET SPORTS BOATING ASSOCIATION" and design for "organizing, promoting, and conducting personal watercraft races and events"; the words "INTERNATIONAL JET SPORTS BOATING ASSOCIATION" are disclaimed; and
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> (5) Reg. No. 1,536,845, issued on April 25, 1989, for the mark "IWF INTERNATIONAL WRESTLING FEDERATION" and design for "entertainment services, namely staging wrestling exhibitions and musical performances"; the words "INTERNATIONAL" and "WRESTLING FEDERATION" are disclaimed.

The Examining Attorney, in view of the above evidence, maintains that (footnote omitted):

> The applicant has already conceded the descriptiveness of the two terms "BASKETBALL LEAGUE" by entering a disclaimer of the terms. The only issue on appeal involves the descriptiveness of the term INTERNATIONAL in relation to the applicant's services. The third[-]party registrations provided by the Examining Attorney all involved sporting activities, e.g., [games,] martial arts, hockey, watercraft races and wrestling. The services identified in those registrations also involved sporting event competitions. The term "INTERNATIONAL" was disclaimed along with the other descriptive wording in these marks ....
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> These disclaimers of the term "INTERNATIONAL" in connection with sporting competitions underscore the term's descriptive meaning. *See* 15 U.S.C. Section 1056; TMEP section 1213. As used by others in the sports competition field, "INTERNATIONAL" describes the scope or nature of the sporting events. For example, the sporting events may involve international competitions between different countries or may feature participants from different countries. Therefore, the term is considered descriptive of a feature of these services.

> The applicant's mark "INTERNATIONAL BASKETBALL LEAGUE" is no different from the third[-]party registrations discussed above. The applicant's services involve an association or league featuring international basketball competitions. Therefore, the entire mark consists of descriptive and generic terms and the entire mark is considered merely descriptive of the applicant's services under Section 2(e)(1) of the Trademark Act.

As to applicant's reliance "on Registration No. 1,546,808, a cancelled registration for the mark 'INTERNATIONAL FOOTBALL LEAGUE,' as precedent for allowing its mark," the Examining Attorney insists that: "[T]he vast majority of registrations containing the term 'INTERNATIONAL' for sporting competitions have either disclaimed the term or were registered on the Supplemental Register. On balance, Office practice has been to hold the term 'INTERNATIONAL' descriptive and therefore to require a disclaimer of the term." Finally, the Examining Attorney additionally points out that:

> The ... Board and federal courts have considered and held the term "INTERNATIONAL" merely descriptive in relation to different services. For example, the mark "INTERNATIONAL BANKING INSTITUTE" was held merely descriptive in connection with organizing seminars and conferences related to international topics and issues. *In re Institutional Investor, Inc.*[,] 229 USPQ 614 (TTAB 1986); "INTERNATIONAL TRAVELERS CHEQUE" was held merely descriptive of financial services. *International Travelers Cheque Co. v. Bankamerica Corp.*, 211 USPQ 753 (7th Cir. 1981); "INTERNATIONAL TRAVEL AGENTS' TRAINING SCHOOL" was held generic in relation to travel agency and travel agent school services. *Travel Bug Ltd. v. Muscarello,* 4 USPQ2d 1444 (N.D. Illinois 1987).

It is well settled that a term or phrase is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute or idea about them. Moreover, whether a term or phrase is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

We agree with the Examining Attorney that, utilizing the above test, the phrase "INTERNATIONAL BASKETBALL LEAGUE," as applied to the entertainment services of organizing and conducting basketball competitions and exhibitions "immediately

describes [a league or] association of basketball teams involved in international competition." As the Examining Attorney has accurately observed, "[t]he applicant has not denied that its services involve international competitions," as the term "international" is defined in the dictionary definition of record, and the third-party registrations demonstrate that current Patent and Trademark Office practice is to treat such term as merely descriptive when applied to activities involving sporting events or competitions. Accordingly, and in light of case law precedent, because the phrase "INTERNATIONAL BASKETBALL LEAGUE" conveys forthwith a significant feature or characteristic of applicant's services, it is merely descriptive thereof within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) is affirmed.

R. L. Simms

G. D. Hohein

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board